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In re Application of :  
OKUNO, et al. :  
U.S. Application No. 10/590,822 :  
PCT No.: PCT/JP05/03055 :  
Int. Filing Date: 24 February 2005 :  
Priority Date: 26 February 2004 :  
Attorney Docket No.: 1035-652 :  
For: SAMPLE TARGET HAVING SAMPLE :  
SUPPORT SURFACE WHOSE FACE IS :  
TREATED, PRODUCTION METHOD :  
THEREOF, AND MASS :  
SPECTROMETER USING THE SAMPLE :  
TARGET :

**DECISION ON PETITION**

This decision is in response to applicant's petition to withdraw the holding of abandonment filed 01 August 2008 in the United States Patent and Trademark Office (USPTO). Additionally, this decision is issued in response to the declaration submitted on 01 August 2008 which is being treated as a Request under 37 CFR 1.42. No petition fee is required.

**BACKGROUND**

On 24 February 2005, applicant filed international application PCT/JP05/03055 which claimed priority of an earlier application filed 26 February 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 September 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 26 August 2006.

On 25 August 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 26 April 2007, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).



On 07 July 2008, applicant was mailed a Notification of Abandonment (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the Form PCT/DO/EO/905 mailed 26 April 2007 within the time period set therein and that above-identified application was abandoned as to the United States.

On 01 August 2008, applicant filed the petitions considered herein.

### **DISCUSSION**

#### **I. Petition Under 37 CFR 1.181 to Withdraw Holding of Abandonment**

The Manual of Patent Examining Procedure (MPEP) at 711.03(c) and the Official Gazette, at 1156 OG 53, provides the grounds that an Office action was not received:

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner \*\*>describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm.

Applicant has provided a statement that the Form PCT/DO/EO/905 was never received, explained that a search of the file jacket and application contents revealed that the Form PCT/DO/EO/905 had not been received; and included a copy of the relevant docket record. Further, applicant has provided a statement describing the firm's docketing system and that the docketing system is sufficiently reliable. Thus, applicant has provided the proper showing necessary to withdraw the holding of abandonment and the petition may be properly granted.



## II. Submission Under 37 CFR 1.42 (Declaration)

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by (all of the) heirs of the inventor, where no legal representative has been appointed.

The declaration submitted on 01 August 2008 was executed by Naoko Okuno as "heiress" to the deceased inventor, Shoji Okuno. However, the declaration does not state that Naoko Okuno is the sole heir of the deceased inventor. Absent a statement that the signing heir is the sole heir of the deceased inventor, the declaration cannot be accepted under 37 CFR 1.42.

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the citizenship for **both** the deceased inventor and the legal representative must be identified on the declaration (as well as the mailing address and residence information of the legal representative and all other information required under 37 CFR 1.497). Here, the declaration filed on 01 August 2008 provides the citizenship for only one individual and it is unclear whether this information is for the Naoko Okuno or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

Applicant must provide a revised declaration executed by the legal representative of the deceased inventor (or all his heirs) that includes all required information, including the citizenship of the deceased inventor and the person(s) signing on his behalf. Such declaration must also make clear on its face, or be accompanied by a statement and/or supporting documentation confirming, that the persons executing the declaration on behalf of the deceased inventor are the only heirs of the deceased inventor.



**CONCLUSION**

For the reasons above, the request is **GRANTED**. The holding of Abandonment is withdrawn.

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicants are required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.



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